

REMARKS

Claims 20-31 are pending in this application, of which all the pending claims have been added in this Response. Claims 1-19 have been cancelled in this Response.

Claims 20 and 27 are supported at original claims 1 and 5; page 11, lines 11-16; page 10, lines 13-18; and page 13, line 25 to page 14, line 7. Claims 21 and 28 are supported at page 11, lines 11-16. Claim 22 is supported at original claim 2. Claim 23 is supported at original claim 3. Claim 24 is supported at original claim 5. Claim 25 is supported at original claim 6. Claim 26 is supported at page 10, line 18 to page 11, line 10; and page 11, line 17 to page 12, line 3. Claims 27 and 31 are supported at page 10, line 18 to page 11, line 10. Claim 29 is supported at original claim 8. Claim 30 is supported at original claim 11.

(1) Claims 1-19 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement as to the previously claimed concentration of “sulfamic acid or its salts.”

In newly added claims 20 and 27, the concentration of “nickel sulfamate” is recited, which is supported at page 7, lines 3-8.

Amendment
Application No. 10/719,020
Attorney Docket No. 032130

- (2) Claims 5-19 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Claims 5-19 have been cancelled, and claims 20-31 have been added. Applicants believe that the rejection is overcome by the newly added claims.

- (3) Claims 5-10 and 14-16 were rejected under 35 U.S.C. §102(b) as being anticipated by Kiyokawa (U.S. Patent No. 5,961,808).

Kiyokawa discloses a metal film resistor having fuse function. As disclosed in Fig. 1 and col. 2, lines 32-60, the nickel-phosphorus alloy film 2 is formed on the ceramic substrate 1. The ceramic substrate is not conductive. On the other hand, the present invention is directed to a circuit board material and a method for preparing the same. The circuit board material of the present invention has a conductive metal foil as the substrate. Thus, the rejection of newly added claims 20 and 27 under 35 U.S.C. §102(b) is not supported by Kiyokawa. Reconsideration of the rejection is respectfully requested.

- (4) Claims 5-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rice et al. (US 4,888,574) in view of Kazanovtse et al. (WPI World Patent Information Derwent, Vol. 29).

With respect to the declaration filed before, the Examiner states that it is unclear whether the quantitative differences between Examples and Comparative Examples are obtained over the entire range of claimed nickel ions, sulfamic acids and salts, and claimed phosphorus containing acids and salts. In this Response, the scope of claims 20 and 27 has been limited into the nickel sulfamate. The declaration at least shows that the range disclosed by Kazanovtse (nickel sulfamate of 120-140g/l) is poor in view of the unevenness of the appearance. On the other hand, comparison of the Examples 1-5 with the Comparative Examples 3 and 4 presented in the declaration shows that the Examples 1-5, prepared in the plating bath including nickel sulfamate at a concentration of 350g/l and 450g/l, showed much better appearance. Therefore, the unexpected results of the present invention can be found in the range of the claimed nickel sulfamate concentration. Thus, the present invention is not obvious over Rice et al. in view of Kazanovtse et al. Reconsideration of the rejection is respectfully requested.

(5) Claims 1, 3 and 5-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Atobe JP59-50190.

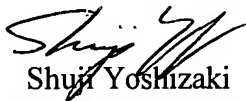
Atobe merely discloses a nickel phosphorus alloy electroplating bath, and does not disclose a circuit board material. Atobe discloses plating a carbon steel to prepare a watch part to show good corrosion resistance against sweat. Atobe does not disclose preparing a circuit board material and a conductive metal foil as recited in claims 20 and 27. The plated material taught

Amendment
Application No. 10/719,020
Attorney Docket No. 032130

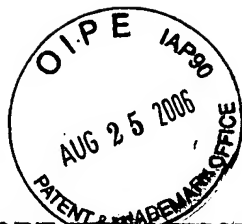
by Atobe is not adhered to an insulating material as recited in claim 26, nor etched as recited in claim 31. A translation of Atobe can be prepared and submitted upon request. Reconsideration of the rejection is respectfully requested.

(6) In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date. If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned representative at the telephone number indicated below to arrange for an interview to expedite the disposition of this case. If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP


Shuji Yoshizaki
Limited Recognition
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

SY/mt
Attachment: Limited Recognition



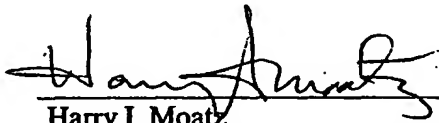
**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATES PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Shuji Yoshizaki is hereby given limited recognition under 37 CFR §10.9(b) as an employee of Westerman Hattori Daniels & Adrian, LLP. to prepare and prosecute patent applications wherein the patent applicant is the client of Westerman Hattori Daniels & Adrian, LLP., and the attorney or agent of record in the applications is a registered practitioner who is a member of Westerman Hattori Daniels & Adrian, LLP. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Shuji Yoshizaki ceases to lawfully reside in the United States, (ii) Shuji Yoshizaki's employment with Westerman Hattori Daniels & Adrian, LLP. ceases or is terminated, or (iii) Shuji Yoshizaki ceases to remain or reside in the United States on an H-1B visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: July 7, 2007



Harry I. Moatz
Director of Enrollment and Discipline